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| 10/579,669 | 05/17/2006 | Roumen Antonov | 01679/17 | 9400 |
| 26646 7590 01/25/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004 | | | | |
| EXAMINER | | | | |
| LEWIS, TISHA D | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3681 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,669

Applicant(s)

ANTONOV ET AL.

Examiner

TISHA D. LEWIS

Art Unit

3681

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 12 and 14 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

The following is a response to the amendment received on October 25, 2007 which has been entered.

Response to Amendment

Claims 1-7, 9-12 and 14 are pending in the application. Claims 8 and 13 are cancelled.

-The drawing objection has been withdrawn due to applicant cancelling claim 13.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. As to applicant's argument concerning the Biallas reference using more coupling devices to obtain gear ratios between the upper and lower shafts, although this is true, the limitations for claim 1, still doesn't suggest that "only" one activator is engaged to obtain a ratio. As to applicant's argument concerning the Biallas reference having a complicated means of operation between power paths, this is acknowledged, but the limitations are not representative of the arguments (i.e., provide limitations as to how applicant's power paths differ from the prior art in terms of providing a new ratio). As to applicant's argument concerning the lower shaft of the prior art reference being interrupted during shifting, being that the limitation of claim 1 discloses that "during engagement process.....each power sub path is uninterruptible between the upper and lower shaft, the prior art reference of Biallas can still meet this limitation because the input clutches (24, 44 and 64) have to be engaged before the ratio is obtained therefore providing uninterruptible power between the upper and lower shafts during

engagement. Examiner suggest applicant amend this particular limitation to suggest that the path between the upper and lower shafts is not interrupted during disengagement process and explain why or how. As to applicant's argument concerning the 103(a) rejection of claims 5 and 12, the same response about the claim limitations not suggesting "only" one activator applies for this argument as well.

Claim Objections

Claim 1 is objected to because of the following informalities:

-In claim 1, line 10, the term "activator" has been misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 9-12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, line 10, the addition of the word "type" to an otherwise definite expression extends the scope of the expression so as to render it indefinite (MPEP 2173.05 (b)E).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 6, 7, 9 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Biallas. As to amended claim 1, Biallas discloses a multiple gear ratio transmission having an upper shaft (20), a lower shaft (40), at least two power paths (14, 16 and 18) which are capable of interconnecting the upper shaft and the lower shaft, wherein each power path comprises at least two power sub paths (14 is between 5th and 2nd, 16 is between 1st, 4th and reverse and 18 is between 6th and 3rd) and each defines a respective transmission ratio (1st to 6th gear) between the upper and lower shafts, for each power sub path, one respective selective gradual activator (24, 44, 64 has to be engaged to provide engine speed to load speed) able during engagement process to match engine speed to load speed wherein each power sub path is uninterruptible (as long as clutches are engaged) between the upper and lower shafts except by disengagement of its respective selective activator.

The rejection for claims 3, 4, 6, 7, 9 and 14 are the same as filed in the office action filed on April 20, 2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biallas in view of Egyed. See rejection filed April 20, 2007.

Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biallas in view of UK patent to Ashfield. See rejection filed April 20, 2007.

Allowable Subject Matter

Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 571-272-7093. The examiner can normally be reached on M-F 9AM TO 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 21, 2008
/TISHA D. LEWIS/
Primary Examiner, Art Unit 3681

Application Number**Application/Control No.**

10/579,669

**Applicant(s)/Patent under
Reexamination**

ANTONOV ET AL.

Examiner

TISHA D. LEWIS

Art Unit

3681